

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: SHAI=8

In re Application of:)	Confirmation No.: 3380
)	
Yechiei SHAI)	Art Unit: 1654
)	
Appln. No.: 10/583,996)	Examiner: R. T. NIEBAUER
PCT/IL04/01157)	
)	
Filing Date: December 22, 2003)	August 4, 2008
371(c) Date: June 11, 2007)	
)	MONDAY
For: DIASTEREOMERIC PEPTIDES)	
USEFUL AS INHIBITORS OF)	
MEMBRANE PROTEIN ASSEMBLY)	

REPLY TO RESTRICTION AND ELECTION
OF SPECIES REQUIREMENTS

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

The Applicant is in receipt of the Office Action mailed July 2, 2008, solely in the nature of restriction and election of species requirements on the basis of purported lack of unity of invention.

First, restriction has been required between what the PTO deems as being two (2) patentably distinct inventions. As applicant must make an election even though the requirement is traversed, applicant hereby respectfully and provisionally

elects Group 1, presently claims 1-22, with traverse and without prejudice.

The PTO takes the position that unity of invention is destroyed by the cited document. In more detail, the Action states that Gerber et al (JMB 2002, 322: 491-495), hereinafter Gerber, teaches that glycophorin A is a transmembrane protein. The Examiner further states that Gerber teaches peptides that correspond to the transmembrane domain of glycophorin A. The Examiner indicates that Gerber teaches all D-amino acid versions of the peptides which meet the limitations of claim 1 of the instant application since an all D-amino acid version is a derivative/analog of a peptide which has L-amino acids at particular residues. The Examiner there concludes that the technical features of the present invention therefore are not a contribution over the prior art.

Applicant respectfully disagrees, it being respectfully noted that the present invention relates **only** to diastereomeric peptides (see, for example, paragraphs [0011] through [0013] of the published version of the present application, US 2008/0096809). The present invention further discloses that while it was believed, prior to the filing of the present application, that the recognition between a transmembrane domain of a membrane protein and a peptide within the cell membrane is dependent upon the secondary

structure of both the protein and the peptide, the present invention discloses unexpectedly that this requirement is not essential as diastereomeric peptides which correspond to a fragment of a transmembrane domain of a membrane protein do interact with the transmembrane domain of membrane proteins (see paragraph [0014] of the published application).

Moreover, the present application explicitly lists the advantages of diastereomeric peptides over all L-amino acid peptides and all D-amino acid peptides (see paragraph [0015] of the published application). In contrast, Gerber discloses all D-amino acid peptides. Gerber does not disclose diastereomeric peptides. Thus, applicant respectfully disagrees with the Examiner's statement that the technical features of the present invention are not a contribution over the prior art.

Consequently, it should be clear that Gerber does not destroy unity of invention, and Groups 1 and 2 do relate to a single general inventive concept under PCT Rule 13.1 because they share the same corresponding special technical features per PCT Rule 13.2. Accordingly, withdrawal of the requirement is in order and is respectfully requested.

The PTO has also required applicant to elect a single peptide species. Again, as applicant must make an

election even though the requirement is traversed, applicant hereby respectfully and provisionally elects, with traverse and without prejudice, the diastereomeric peptide corresponding to bacterial protein aspartate Tar receptor. The claims which read on this elected species are generic claims 1-3 and more specific claims 18-21.

The requirement is respectfully traversed on the basis that the very nature of the generic claims inherently defines a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, these generic claims recite (cover) the same or corresponding special technical features.

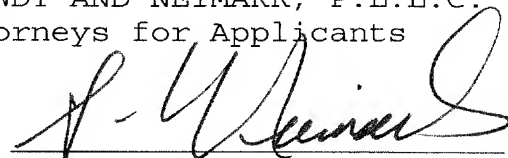
Accordingly, withdrawal of the election of species requirement is also in order and is respectfully requested.

Applicant now respectfully awaits the results of a first examination on the merits.

Respectfully submitted,

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